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EXAMINER	
LAFORGIA, CHRISTIAN A	

ART UNIT	PAPER NUMBER
2131	

DATE MAILED: 10/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/065,119	ELLIS, ANTHONY	
	Examiner	Art Unit	
	Christian La Forgia	2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 August 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *25-35* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *25-35* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *07 August 2006* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. The amendment filed on 15 August 2006 has been noted and made of record.

2. Claims 1-24 have been cancelled as per the Applicant's request.

3. Claims 25-35 have been presented for examination.

Response to Arguments

4. Applicant's arguments filed 15 August 2006 have been fully considered but they are not persuasive.

5. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

6. In response to the Applicant's arguments that *Chase* is not a proper prior art reference, although the Applicant admits that it was filed less than six months ***prior*** to Applicant's application, the Examiner disagrees and would like to remind the Applicant of the 35 U.S.C. 102(e) which states:

> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Chase qualifies as prior art under the abovementioned statute and is therefore proper as a prior art reference. As far as predating the Applicant's inventive date, the Applicant has not produced an affidavit or declaration under 37 CFR 1.131 to antedate the reference, and therefore *Chase* still qualifies as prior art and the rejection is maintained.

7. See further rejections that follow.

Specification

8. The use of the trademarks Microsoft Internet Explorer, Netscape Navigator, and Opera has been noted in this application. They should be capitalized wherever they appear and be accompanied by the generic terminology.

9. Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Objections

10. Claim 34 is objected to because of the following informalities: The claim language reads "to send instant messages users instantly." For the examination proceedings the Examiner will interpret the claim limitation as "to send instant messages to users instantly." Appropriate correction is required.

Claim Rejections - 35 USC § 101

11. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

12. As per claim 35, citing claim limitations as a computer function representing a computer listing *per se* (based on paragraphs 60 and 61 from the Specification), that is, descriptions or expressions of such a program and that is, descriptive material *per se*, non-functional descriptive material, and is not statutory because it is not a physical "thing" nor a statutory process, as there are not "acts" being performed. Such claimed computer functions do not define any structural and functional interrelationships between the computer function and other claimed aspects of the invention which permit the computer function's functionality to be realized. Since a computer

function is merely a set of instructions capable of being executed by a computer, the function itself is not a process, without the computer-readable medium needed to realize the computer function's functionality. In contrast, a claimed computer-readable medium encoded with a computer function defines structural and functional interrelationships between the computer function and the medium which permit the computer function's functionality to be realized, and is thus statutory. **Warmerdam**, 33 F.3d at 1361, 31 USPQ2d at 1760. **In re Sarkar**, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978). See MPEP § 2106(IV)(B)(1)(a).

Claim Rejections - 35 USC § 112

13. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. Claim 35 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: securing encryption and secure distribution of a file or digital information using a download generating script; installing a monitoring component at user end; and having monitoring component checks file access rights through a communication means and having monitoring component control access to file or digital information based on password rights received from a server. Claim 35 sets forth a method, but fails to disclose any method steps.

Claim Rejections - 35 USC § 103

15. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

16. Claims 25-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,920,567 to Doherty et al., hereinafter Doherty, in view of U.S. Patent Application Publication No. 2001/0034712 to Colvin, hereinafter Colvin, and further in view of U.S. Patent Application No. 2002/0166056 to Johnson et al., hereinafter Johnson and further in view of U.S. Patent Application Publication No. 2003/0187801 to Chase, Jr. et al., hereinafter Chase.

17. As per claim 25, Doherty teaches a method of controlling usage and distribution of electronic information comprising:

securing encryption and secure distribution of a file or digital information using a download generating script (column 5, line 47 to column 6, line 6, column 7, lines 3-23, column 8, lines 37-59, i.e. constructing a digital content file to be distributed and installed by a user system);

installing a monitoring component at user end (Figure 1a [block 16], column 4, line 63 to column 5, line 3, column 5, line 47 to column 6, line 15, column 8, lines 1-6, i.e. installing license monitor and control mechanism that is associated with the file access control mechanism); and

having monitoring component checks file access rights through a communication means and having monitoring component control access to file or digital information (column 8, lines 7-36, column 9, lines 6-23, i.e. the access control mechanism executes the requirements to obtain license information defining a license allowing use of the digital contents, generates license information defining a license for use of the digital content in the user system and provides the license information defining a license for use of the digital content in the user system to the user system).

18. Doherty does not disclose wherein the file access rights are checked at time intervals or where the control access is based on password rights received from a server;

wherein access and usage rights to the file can be changed or revoked;

said monitoring component checks file password rights at time intervals through a communication means to a remote server;

said password being used by the monitoring control unit to control the access rights to the file.

19. Colvin teaches wherein the file access rights are checked at time intervals or where the control access is based on password rights received from a server (paragraphs [0047], [0048], [0050], [0053], i.e. authorization intervals, and password transferred to user/software);

wherein access and usage rights to the file can be changed or revoked (paragraph [0053]);

said monitoring component checks file password rights at time intervals through a communication means to a remote server (paragraphs [0047], [0048], [0050], [0053], i.e. authorization intervals, and password transferred to user/software);

said password being used by the monitoring control unit to control the access rights to the file (paragraphs [0047], [0048], [0050], [0053]).

20. It would have been obvious to one of ordinary skill in the art at the time the invention was made to check the file access rights at regular intervals and control access based on password rights received from the server, since Colvin states at paragraph [0053] that a password may be used to disable the content if an unauthorized user is detected, thereby acting as a deterrent to piracy.

21. Doherty and Colvin do not disclose said securing encryption is done by a File Owner.

22. Johnson teaches said securing encryption is done by a File Owner (Figure 2 [blocks 242, 246, 248], paragraphs [0053], [0057]-[0058]).

23. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the file owner encrypt the content and upload it to a server, since Johnson states at paragraph [0005] that it would provide a way to secure digital content that could not be easily defeated, yet not impede the end-user's ability to use the content, while ensuring that the file owner is duly compensated for the use of their content.

24. Doherty, Colvin, and Chase do not disclose allowing a File Owner to change access and usage rights to a given file or a given End User.

25. Chase teaches allowing a File Owner to change access and usage rights to a given file (paragraph [0146]) or a given End User (paragraph [0010], [0319]).

26. It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the file owner to change the privileges associated with the file and user, since Chase states at paragraphs [0007]-[0010] that such a modification would allow a file owner to disable a file if it is found out that the file has been distributed without permission.

27. Regarding claims 26 and 27, Doherty, Colvin, and Chase do not disclose said securing encryption is done by a File Owner on File Owner's computing device and then uploaded to a server using a communication means.

28. Johnson teaches said securing encryption is done by a File Owner on File Owner's computing device and then uploaded to a server using a communication means (Figure 2 [blocks 242, 246, 248], paragraphs [0053], [0057]-[0058]).

29. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the file owner encrypt the content and upload it to a server, since Johnson states at paragraph [0005] that it would provide a way to secure digital content that could not be easily defeated, yet not impede the end-user's ability to use the content, while ensuring that the file owner is duly compensated for the use of their content.

30. Regarding claim 28, Doherty, Johnson, and Chase do not teach said monitoring component checks file password rights at time intervals through a communication means to a remote server when the file is accessed.

31. Colvin teaches said monitoring component checks file password rights at time intervals through a communication means to a remote server when the file is accessed (paragraphs [0047], [0048], [0050], [0053], i.e. authorization intervals, and password transferred to user/software).

32. It would have been obvious to one of ordinary skill in the art at the time the invention was made to check the file access rights at regular intervals and control access based on password rights received from the server, since Colvin states at paragraph [0053] that a password may be used to disable the content if an unauthorized user is detected, thereby acting as a deterrent to piracy.

33. Regarding claims 29 and 30, Doherty, Johnson, and Chase do not disclose the steps of having an auto-generation of password for file access and having said password being used by the access monitor to control the access rights to the file.

34. Colvin teaches the steps of having an auto-generation of password for file access and having said password being used by the access monitor to control the access rights to the file (paragraphs [0047], [0048], [0050], [0053]).

35. It would have been obvious to one of ordinary skill in the art at the time the invention was made to automatically generate password files for access rights, since Colvin states at paragraph [0053] that a password may be used to disable the content if an unauthorized user is detected, thereby acting as a deterrent to piracy.

36. Regarding claim 31, Doherty teaches an administrator function (column 34, lines 44-59).

37. Regarding claim 32, Doherty teaches the steps of allowing the End User to move the file from one computing device to another (column 38, lines 3-7).

38. Regarding claim 33, Dougherty teaches the steps of allowing the End User to move the file from one computing device to another by un-registering the file and re-registering the file (column 38, lines 3-67).

39. Regarding claim 34, Doherty, Johnson, and Chase do not disclose the steps of having the ability to send instant messages users instantly via the monitoring component.

40. Colvin teaches the steps of having the ability to send instant messages users instantly via the monitoring component (Figures 11 [blocks 442, 450], 12 [blocks 479, 484, 494, 502], paragraphs [0083], [0088]).

41. It would have been obvious to one of ordinary sill in the art at the time the invention was made to have the ability to send instant messages to users, since Colvin discloses at paragraphs [0083] and [0088] that providing messaging allows the system to inform the user of errors entering their keying information, thereby preventing them from accessing the content.

42. As per claim 35, Doherty teaches a method of controlling usage and distribution of electronic information, comprising:

having an FS Encryption Utility function (column 5, line 47 to column 6, line 6, column 7, lines 3-23, column 8, lines 37-59),

having an FS Rights Enforcement Monitor function (Figure 1a [block 16], column 4, line 63 to column 5, line 3, column 5, line 47 to column 6, line 15),

having a Database Management Server (column 8, lines 37-59),

having a Access Management Server (column 10, lines 9-23),

having a File Distribution Server (Figure 2 [block 28], column 12, lines 25-47), and

43. Doherty does not disclose having a File Secure File Owner Server (),having a Message Monitoring System.

44. Johnson discloses having a File Secure File Owner Server (Figure 2 [blocks 242, 246, 248], paragraphs [0053], [0057]-[0058]).

45. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the file owner encrypt the content and upload it to a server, since Johnson states at paragraph [0005] that it would provide a way to secure digital content that could not be

easily defeated, yet not impede the end-user's ability to use the content, while ensuring that the file owner is duly compensated for the use of their content.

46. Colvin discloses having a Message Monitoring System (Figures 11 [blocks 442, 450], 12 [blocks 479, 484, 494, 502], paragraphs [0083], [0088]).

47. It would have been obvious to one of ordinary sill in the art at the time the invention was made to have the ability to send instant messages to users, since Colvin discloses at paragraphs [0083] and [0088] that providing messaging allows the system to inform the user of errors entering their keying information, thereby preventing them from accessing the content.

Conclusion

48. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

49. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

50. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christian La Forgia whose telephone number is (571) 272-3792. The examiner can normally be reached on Monday thru Thursday 7-5.

51. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

52. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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